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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,824	07/30/2003	Nareak Douk	P1354 US	7296
28390	7590	11/02/2005	EXAMINER	
MEDTRONIC VASCULAR, INC. IP LEGAL DEPARTMENT 3576 UNOCAL PLACE SANTA ROSA, CA 95403			AHMED, AAMER S	
			ART UNIT	PAPER NUMBER
			3763	

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/629,824

Applicant(s)

DOUK, NAREAK

Examiner

Aamer S. Ahmed

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 10-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-14 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>01/25/05 03/03/04</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1-9, drawn to an aspiration catheter, classified in class 604, subclass 40.
- II. Claims 10-14, drawn to a method of aspirating a vessel, classified in class 604, subclass 508.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus. The apparatus as claims comprises proximal and distal tubes, the distal tube is unremovably disposed within the first lumen; the process of aspirating a vessel as claimed may be accomplished with any telescopic aspirating catheter.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention:

Group A: Figures 1-3

Group B: Figure 4

Group C: Figure 6

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with James Crittendon on October 26<sup>th</sup>, 2005 a provisional election was made without traverse to prosecute the invention of an aspiration catheter, claims 1, 2 and 4-6. Affirmation of this election must be made by applicant in replying

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to this Office action. Claims 3, and 10-14 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Berthiaume U.S. Patent Number 5,846,259. Berthiaume discloses an aspiration catheter (10) comprising an aspiration shaft (20); a proximal tube (70) having a first lumen extending therethrough, wherein the proximal tube (70) is slidably disposed over the aspiration shaft (20) and a distal tube (60) having a second lumen extending therethrough, wherein the distal tube (60) is slidably disposed over the aspiration shaft (20) distal to the proximal tube, the distal tube is slidably positionable within the first lumen, at least a proximal end of the distal tube is irremovably disposed within the first lumen, and the aspiration shaft is irremovable from the second lumen (col. 5 line 27); and further comprising a guidewire shaft (30) having a guidewire lumen (see figure 1) disposed adjacent to the aspiration shaft (20) (see figure 1); and disposed along a distal segment of the aspiration shaft (20) (see figure 1).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berthiaume in view of Bagosian et al U.S. Patent 6,152,909. Berthiaume discloses the device as described above in reference to claim 1, but fails to disclose that the catheter comprises a distal aspiration port disposed at a distal tip of the aspiration shaft set at an oblique angle. Bagosian describes a similar device with a distal aspiration port (44) disposed at a distal tip of the aspiration shaft is set at an oblique angle (Figure 5). It would have been obvious to one having ordinary skill in the art at the time of invention by the applicant to modify the device of Berthiaume by incorporating the oblique angle aspiration port as taught by Bagosian et al in order to maximize the area of aspiration (Bagosian col. 12 line 5).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berthiaume in view of Ellis et al U.S. Patent Number 5,514,093. Berthiaume discloses the catheter as described above in reference to claim 1 including stop members a first proximal stop fixedly attached to an

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interior surface of the proximal tube on a proximal end thereof (54) and a second proximal stop fixedly attached to an exterior surface of the distal tube on a proximal end thereof (52), and a second distal stop (56) fixedly attached to an interior surface of the distal tube on a distal end, however Berthiaume fails to explicitly disclose that the catheter device further comprises; a third proximal stop fixedly attached to an interior surface of the distal tube on a proximal end thereof; and a fourth proximal stop fixedly attached to an exterior surface of the aspiration shaft in a distal region thereof. Ellis et al discloses a similar device with a first distal stop (20) fixedly attached to the interior surface of the proximal tube on a distal end, a third proximal stop fixedly attached to an interior surface of the distal tube on a proximal end thereof (90); and a fourth proximal stop (48) fixedly attached to an exterior surface of the aspiration shaft in a distal region thereof. It would have been obvious to one having ordinary skill in the art at the time of invention by applicant to modify the catheter device of Berthiaume by incorporating more stops as taught by Ellis et al in order to limit movement of the telescopic tubes.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 5047045 A	Arney; Michelle M. et al.
US 5484409 A	Atkinson; Robert et al.
US 5498240 A	Bagaoisan; Celso S. J. et al.
US 5591194 A	Berthiaume; William A.
US 5484424 A	Cottenceau; Jean-Philippe et al.
US 6562021 B1	Derbin; J. Todd et al.
US 5338301 A	Diaz; Juan-Carlos
US 20040249337 A1	DiFiore, Attilio
US 20050004553 A1	Douk, Nareak
US 20020143360 A1	Douk, Nareak et al.
US 6706055 B2	Douk; Nareak et al.
US 6818006 B2	Douk; Nareak et al.

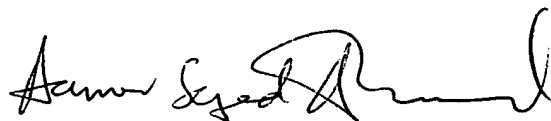
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US 20040193114 A1 Elbert, Linda D. et al.  
US 4917103 A Gambale; Richard A. et al.  
US 5234429 A Goldhaber; Neil G.  
EP 935974 A1 ISMAEL, BERNARD  
US 6406471 B1 Jang; Yue-Teh et al.  
US 6059814 A Ladd; William Gregory  
US 6248092 B1 Miraki; Manouchehr et al.  
US 20050107739 A1 Palma, Giorgio Di  
US 6234995 B1 Peacock, III; James C.  
US 5466222 A Ressemann; Thomas V. et al.  
WO 9401169 A1 TREMULIS, WILLIAM S  
US 5769868 A Yock; Paul G.  
US 6380457 B1 Yurek; Matthew T. et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aamer S. Ahmed whose telephone number is 571-272-5965. The examiner can normally be reached on Monday thru Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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